

REMARKS**ELECTION**

Claims 1-9 are pending in the application. The Office Action sets forth a two-way restriction and requires election of one group of the following claims, which it characterizes as:

- Group I: Claims 1-7, drawn to a method for forming an aluminide coating;
Group II: Claims 8-9, drawn to an article, which upon heating reacts with a target surface and forms an aluminide coating.

Applicant provisionally elects, with traverse, the claims of group I, drawn to a method. By this election, Applicant does not acquiesce that the restriction requirement is proper.

TRAVERSE

The examiner asserts that the inventions of group I and II are related as a product and process of using the product under MPEP §806.05(h). Further, it is asserted these inventions are distinct because the product can be used with a materially different process and the process may be used with a materially different product. Even though the examiner bears the burden of demonstrating distinctness under this section of the MPEP, the office action merely re-iterates the language of §806.05(h) as its conclusion of distinctness and provides no argument justifying why the process and product as claimed are distinct.

More to the point, this characterization of the relatedness between the inventions is incorrect. The inventions of groups I and II are related under MPEP §806.05(f) as product and process of making the product. In this situation, the analysis for distinctness depends on showing that the process as claimed can be used to make other and different products OR that the product as claimed can be made by a materially different process. [Original emphasis in the MPEP].

The process as claimed is a method for forming an aluminide coating on a target surface of a metal substrate bounding a contained space of the substrate, which comprises:

- Positioning coating tape over the contained space of the substrate; and
- Heating the target surface to an effective temperature to form an aluminide coating on the target surface.

PHIP\336218\1

- 2 -

Claim 1 further recites that the coating tape is out of contact with the target surface and comprises a specific mixture of aluminum source and halide activator and at least one binder. The aluminum source comprises 70 to 99% by weight of the mixture and containing about 20wt% to 60wt% aluminum. The halide activator comprises 1% to about 15% by weight of the mixture.

The article as claimed comprises:

- a metal substrate having a target surface bounding a contained space of the substrate; and
- a coating tape disposed over the contained space in an out-of-contact relation with the target surface.

Claim 8 further recites that the coating tape comprises a specific mixture of aluminum source and halide activator and at least one binder in the same percentages by weight as claim 1. Claim 8 recites that heating the metal substrate and coating tape forms an aluminide coating on the target surface of the contained space.

As claimed, the method of claim 1 produces only the aluminide coating of claim 8 and the article of claim 8 can only be produced by the method of claim 1. This is because the following elements which define the process and produce the article are exactly the same in both claims:

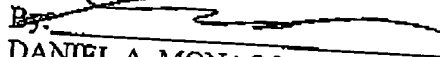
- the same target surface bounded by the metal substrate is recited in both claims;
- the same coating tape comprising the same mixture of the same elements is recited in both;
- the coating tape in both claims lies in an out-of-contact relation with the target surface being coated;
- the same temperature that causes an aluminide coating onto the target surface is recited.

Because these elements, which determine the production of an aluminide coating on the target surface and define the article that is produced, are exactly the same, the process as claimed cannot make a product other than that which is claimed. And, the product as claimed cannot be made by a materially different process. The claimed process and product share a one-to-one correspondence because the intermediary mechanisms for practicing the process and producing the product are the same.

PHIP\336218\1

Because the claimed process and product are related and indistinct, Applicant respectfully submits the restriction requirement to be withdrawn and the examination to proceed on all claims as filed.

Respectfully submitted,
THOMAS KIRCHER

By: 

DANIEL A. MONACO
Registration No. 30,480
Drinker Biddle & Reath LLP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103-6996
Tel: 215-988-3312
Fax: 215-988-2757
Attorney for Applicant

PHIP\336218\1

- 4 -

Received from < > at 10/14/02 4:28:50 PM [Eastern Daylight Time]